REMARKS

Reconsideration and allowance of the above-referenced application are respectfully requested. Claims 1-28 are pending. Claims 1-28 are rejected. Claim 1 is amended to correct a typographical error. Specifically, a comma was added in line 4 after "instructions." No new matter has been added.

Rejection of claims 1-28 under 35 U.S.C. §103(a)

Claims 1-28 stand rejected under 35 USC 103(a) as unpatentable over US Patent Number 6,317,729 to Camp *et al.* ("Camp") in view of US Patent Number 6,108,644 to Goldschlag *et al.* ("Goldschlag"). The Examiner asserts that:

> As per claims 1,20,22,25,28 Camp teaches a method for facilitating a financial transaction over a network(Abstract)(col 3 lines 46-47) comprising a programmable memory device which contains the following for formulating payment instructions network address instructions(col 3 line 46-col 4 line 9). Camp does not explicitly teach a digital certificate and encrytion [sic]. Goldschlag treaches [sic] this(col 4 lines 16-64)(col *5* lines *5* 1-57). Camp teaches issuing software to a second user wherein the software includes payment information of the second user including a second user's financial account information wherein said software is capable of interacting with the programmable memory device over the first network(col 8 line 8-27)(col 11 line 29-cot 12 line 32) as well as formul;ating [sic] a connection between the programmable memory device and the software(col 7 lines 45-46) and receiving across the connection the payment instructions(Fig 2/6/9/10) and routing the payment information and instructions to the issuer utilizing the network(col 11 lines 11-45) as well as receiving the payment information and instructions where the issuer is capable of accessing one of the first user's and second user's financial account information(Fig 1/5)(Fig 2/6)(col 10 line 32)(col 11 lines 29-32)(Table 2).It would have been obvious to one skilled in the art at the time of the invention to combine Camp in view of Goldschlag to teach the above. The motivation to combine is to teach an electronic transaction system to meet the needs of the customer for privacy and the requirements of the vendor for reliability in a single transaction as ennunciated [sic] by Goldschlag(col 4 lines 10-15).
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> As per claim 2 Camp teaches according to claim 1. Camp failsto [sic] teasch [sic] wherein the payment information of the second user further includes a second user's digital certificate. Goldschlag teaches this(col 4 lines 16-64)(col 7 lines 24-32).It would have been obvious to one skilled in the art at the time of the invention to combine Camp in view of Goldschlag to teach the above. The

motivation to combine is to teach an electronic transaction system to meet the needs of the customer for privacy and the requirements of the vendor for reliability in a single transaction as ennunciated [sic] by Goldschlag(col 4 lines *10-15).*

As per claims 3, 10 Camp teaches the method according to claims 1,7 where the first or second network is the Internet(col 7 lines 1 5-22)(col 3 lines 46-49).

As per claims 4,21,23,26 Camp teaches the method according to claims 1,20,22,25 where the network is the Internet(col 7 lines 1 5-22)(col 3 lines 46-49).It would have been obvious to one skilled in the art at the time of the invention to combine Camp in view of Goldschlag to teach the above and to apply wireless communication to these transactions as a means of linking with the Internet. The motivation to combine is to teach an electronic transaction system to meet the needs of the customer for privacy and the requirements of the vendor for reliability in a single transaction as ennunciated [sic] by Goldschlag(col 4 lines 10-15).

As per claim *5* Camp teaches the network of claim 1 wherein the address instructions include a UIRL(col 7 line 22)(col 3 lines 46-49).It would have been obvious to one skilled in the art at the time of the invention to combine Camp in view of Goldschlag to teach the above and to utilize a teelephone [sic] as a connecting electronic medium for transactions. The motivation to combine is to teach an electronic transaction system to meet the needs of the customer for privacy and the requirements of the vendor for reliability in a single transaction as ennunciated [sic] by Goldschlag(col 4 lines 10-15).

As per claim 6 Camp teaches the method of claim 1 including authorizing a payment amount read from the instructions(Table 2).

As per claim 7 Camp teaches the method of claim 6 wherein authorizing a payment amount includes requesting via a second network authorization from a first user's financial institution(col 8 line 40-col 9 line 20).

As per claim 8 Camp teaches the method of claim 7 wherein the payment instructions further include an encrypted PIN recognizable by ther [sic] first user's financial institution for accessing financial account information(col 8 lines *15-27).*

As per claim 9 Camp teaches the method according to claim 7 where the network is the Internet(col 7 lines I 5-22)(col 3 lines 46-49).It would have been obvious to one skilled in the art at the time of the invention to combine Camp in view of Goldschlag to teach the above and to apply an ATM terminal at the customer site to these transactions as a means of linking with the network, The motivation to combine is to teach an electronic transaction system to meet the needs of the customer for privacy and the requirements of the vendor for reliability in a single transaction as ennunciated [sic] by Goldschlag(col 4 lines 10-15).

As per claim 11 Camp teaches the method according to claim 1. Camp teaches wherein the programmable memory device is emploued [sic] (cot 3 line 46-col 4 line 9). Camp dkes [sic] not specifically teach that the programmable device is a smart card. It would have been obvious to one skilled in the art at the

time of the invention to combine Camp in view of Goldschlag to teach the above and to utilize a smart card as one form of a prograsmmable [sic] memory device for these transactions. The motivation to combine is to teach an electronic transaction system to meet the needs of the customer for privacy and the requirements of the vendor for reliability in a single transaction as ennunciated [sic] by Goldschlag(col 4 lines 10-15).

As per claims 12,17 Camp teaches the method according to claim I wherein the first(second) user's financial account information includes his(first) account identifier(col 7 lines *45-50).*

As per claims 13,18 Camp teaches the method according to claims 1,17 wherein the first(second) user's financial account information includes his account identifier or account type(col 7 line 47)(col 7 line 57).

As per claims 14,19 Camp teaches the method according to claim 1 wherein the first(second) user's financial account information includes the financial institutions's [sic] routing number(Table 2).

As per claim 15 Camp teaches the method according to claim 1 wherein the encryption program contains a private key generated by the issuer(col 9 lines 22-3 0).

As per claim 16 Camp teaches the method according to claim 1 wherein the encryption program generates a private/public key pair within the programmable memory device(col 3 lines 25-44)(col 4 lines 4-44)(Table 1).

The applicants respectfully traverse the rejection of the above identified claims under 35 U.S.C. § 103(a) as being unpatentable over Camp in view of Goldschlag. Regarding claim 1, neither Camp nor Goldschlag, either singularly or in combination, teach or suggest, "A method for facilitating a financial transaction over a first network comprising: issuing a programmable memory device to a first user, wherein the programmable memory device contains at least the following for formulating payment instructions network address instructions for an issuer of the programmable memory device, a first user's digital certificate, a first user's financial account information, and an encryption program; issuing software to a second user, wherein the software includes payment information of the second user including a second user's financial account information and further wherein the software is capable of interacting with the programmable memory device over the first network; forming a connection between the programmable memory device and the software; receiving across the connection the payment instructions; adding the second user's payment information to the payment instructions; routing the payment information and the payment instructions to the issuer utilizing the network address instructions; and receiving the payment information and the payment instructions, wherein the issuer is capable of

accessing at least one of the user's financial account information and a second user's financial account information" as recited in claim 1 of the present application.

Claim 1 of the present invention requires the step of "issuing a programmable memory device to a first user, wherein the programmable memory device contains at least the following for formulating payment instructions network address instructions for an issuer of the programmable memory device, a first user's digital certificate, a first user's financial account information, and an encryption program." The programmable memory device, e.g., a smart card (see e.g., page 11, line 11 – page 12, line 15), contains all of the relevant customer data to enable a customer to make a purchase over a variety of networks, terminals and servers.

The Examiner asserts that "Camp teaches a method for facilitating a financial transaction over a network ... comprising a programmable memory device which contains the following for formulating payment instructions network address instructions " The Examiner cites column 3, line 46 – column 4, line 9 as teaching this step/element. The cited section neither teaches nor suggests such a programmable memory device. Camp is directed to a method for certifying delivery of secure electronic transaction (SET) and does not disclose the hardware used in such SET transactions. Therefore, Camp does not teach or suggest the programmable memory device of claim 1. In addition, Goldschlag does not teach or suggest the programmable memory device of claim 1. As a result, neither Camp nor Goldschlag, either singularly or in combination, teach or suggest the step of issuing such a programmable memory device.

Pursuant to the requirements for establishing a *prima facie* case of obviousness under 35 U.S.C. §103, all the claim limitations must be taught or suggested by the prior art. In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). Referring to MPEP Section 2142,

> [t]o establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, **the prior art reference (or references when combined) must teach or suggest all the claim limitations**. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on the applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

(emphasis added). Thus, since neither Camp nor Goldschlag, either singularly or in combination, teach or suggest the step of "issuing a programmable memory device to a first user, wherein the programmable memory device contains at least the following for formulating payment instructions network address instructions for an issuer of the programmable memory device, a first user's digital certificate, a first user's financial account information, and an encryption program," the Examiner has failed to establish a *prima facie* case of obviousness.

For at least these reasons, claim 1, as well as dependent claims 2-19 are patentable over the cited art. Accordingly, it is respectfully requested that the rejection be reconsidered and withdrawn.

Regarding independent claim 20, neither Camp nor Goldschlag teach or suggest "A system for facilitating financial transactions over a network comprising: a programmable memory device including at least an identifying certificate, payment information, network routing instructions and an encryption program; a first server for offering at least one product via the network through a terminal; a processor connected the terminal for (a) accessing the programmable memory device, (b) retrieving the identifying certificate, the payment information, the network routing instructions and the encryption program off of the programmable memory device ..." (emphasis added). Thus, as stated above, neither Camp nor Goldschlag, either singularly or in combination, teach or suggest such a programmable memory device, thus the Examiner has failed to establish a *prima facie* case of obviousness.

For at least these reasons, claim 20, as well as dependent claim 21 are patentable over the cited art. Accordingly, it is respectfully requested that the rejection be reconsidered and withdrawn.

Regarding independent claim 22, neither Camp nor Goldschlag teach or suggest "A method for performing a financial transaction comprising: presenting a customer with an amount due in response to a customer's product selection; accepting a customer's programmable memory device within a reader portion of a terminal to facilitate payment of the amount due; accessing a portion of the customer's programmable memory device containing payment information, wherein the payment information includes at least network address instructions for an issuer of the customer's programmable memory device, a digital certificate for identifying the customer, the customer's financial account information, an encryption program, and a customer memo balance containing updated customer account balances ..." (emphasis added). Thus, as

stated above, neither Camp nor Goldschlag, either singularly or in combination, teach or suggest such a programmable memory device, thus the Examiner has failed to establish a *prima facie* case of obviousness.

For at least these reasons, claim 22, as well as dependent claims 23-24 are patentable over the cited art. Accordingly, it is respectfully requested that the rejection be reconsidered and withdrawn.

Regarding independent claim 25, neither Camp nor Goldschlag teach or suggest "A system for performing a financial transaction comprising: means for presenting a customer with an amount due in response to a customer's product selection; means for accepting a customer's programmable device within a reader portion of a terminal to facilitate payment of the amount due; means for accessing a portion if the customer's programmable memory device containing payment information, wherein the payment information includes at least network address instructions for an issuer of the customer's programmable memory device, a digital certificate for identifying the customer, the customer's financial account information, an encryption program, and a customer memo balance containing updated customer account balances ..." (emphasis added). Thus, as stated above, neither Camp nor Goldschlag, either singularly or in combination, teach or suggest such a programmable memory device, thus the Examiner has failed to establish a *prima facie* case of obviousness.

For at least these reasons, claim 25, as well as dependent claims 26-27 are patentable over the cited art. Accordingly, it is respectfully requested that the rejection be reconsidered and withdrawn.

Regarding independent claim 28, neither Camp nor Goldschlag teach or suggest "A system for facilitating a financial transaction comprising: a programmable device issued to a suer including (a) at least one processor; (b) a digital certificate identifying the user; (c) the user's financial account information, (d) network addressing instructions for at least the issuer of the programmable memory device; and an encryption program for encrypting at least (b) and (c); a terminal for reading information from the programmable memory device to facilitate a payment from at least one of a user's financial accounts ..." (emphasis added). Thus, as stated above, neither Camp nor Goldschlag, either singularly or in combination, teach or suggest such a programmable memory device, thus the Examiner has failed to establish a *prima facie* case of obviousness.

For at least these reasons, claim 28 is patentable over the cited art. Accordingly, it is respectfully requested that the rejection be reconsidered and withdrawn.

The above-identified arguments clearly establish the patentability of the claims over the cited art. The applicants acknowledge that the Examiner has included various other arguments regarding the claim limitations. The applicants do not concede to or agree with these arguments, but instead proffer that these arguments are moot in view of the arguments presented herein. Thus, for at least these reasons, claims 1-28 are patentable over Camp in view of Goldschlag. As a result, the applicants respectfully request that the rejection of claims 1-28 under 35 U.S.C. §103(a) be withdrawn.

The foregoing is submitted as a full and complete Response to the non-final Office Action mailed 26 June 2002, and early and favorable consideration of the claims is requested. If the Examiner believes any informalities remain in the application which may be corrected by Examiner's Amendment, or if there are any other issues which may be resolved by telephone interview, a telephone call to the undersigned attorney at (202)508-5889 is respectfully solicited.

Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 50-1458, and please credit any excess fees to such deposit account.

Respectfully submitted,

Dated: 11/26/02

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